

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the Specification and Claims, the attached Declaration of Mr. Yanagisawa and the following remarks.

Claim Status and Amendments

Claims 1-20 are pending in this Application. Claims 1-20 had been examined and the amendment to the claims does not cancel any claims. Thus, Claims 1-20 are still pending in this Application.

Claims 1, 4, 7 and 10 have been amended herein to change "organic silver halide salt" to "organic silver salt". Support for this amendment can be found on page 70 where it teaches that the silver salt is an organic silver salt.

Specification Amendments

The Examiner requested that the Specification be reviewed for correction of minor errors. In that vein, the Specification has been reviewed and a number of minor errors have been noted and are corrected herein.

Specification Rejection Under 35 USC 112

The amendment filed on August 20, 2003 was objected to as containing new matter. Respectfully, it is submitted that the amendment presented on August 20, 2003 was nothing more than a minor amendment to correct obvious typographical errors. Thus, Applicants request that the Examiner reconsider his position on the August 20, 2003 amendment and submit the following discussion for his consideration.

The Amendment presented on August 20, 2003 was an amendment to Figures 2 and 3. Figures 2 and 3 as filed allegedly represented a plot for Samples Nos. 1 through 16 as reported in Tables 1, 2 and 3 of the Application. Tables 1, 2 and 3 in the Application, however, only contain 15 samples. Thus, the question is: which sample number in Figures 2 and 3, which is plotted, is not recited in Tables 1-3? The answer to the question is Sample

No. 8 in Figure 2 does not correspond to the data in Tables 1 and 2. Thus, the Amendment filed on August 20, 2003 presented Substitute Figures 2 and 3 which did not contain the line for Sample No. 8 from Figure 2 as filed. Thus, Figures 2 and 3, as presented in the Amendment filed August 20, 2003, corresponds with the data in Tables 1-2 as recited in the Application. Respectfully, the Substitute Figures 2 and 3 do not enter new matter into the Application but simply correct an obvious discrepancy between the plot in Figures 2 and 3 and the data in Tables 1-3 of the Application. The plot in Substitute Figures 2 and 3 is identical to the plot in Figures 2 and 3 as filed except for the fact that a plot for Sample No. 8, as it appears in Figure 2 as originally filed, is absent. This plot is absent because the data did not appear in the Application.

The Examiner is respectfully requested to reconsider his position and to approve Figures 2 and 3 as presented in the Preliminary Amendment dated August 20, 2003.

Claim Rejections

The Examiner has put forward eight different rejections based on the prior art and had taken the position that the prior art inherently teaches the claim coefficient of determination, R^2 . As

brought out in the Declaration of Mr. Yanagisawa, none of these references inherently possess the R^2 value as recited in the claims and, thus, it is submitted that Applicants' claimed Invention is patentable over each one of these cited references. A more detailed explanation follows.

The Examiner has essentially put forward six prior art rejections. Specifically:

1. Claims 1-20 are rejected as being anticipated by or obvious over EP 1278108.
2. Claims 1-20 are rejected as being anticipated by or obvious over Nishijima (US Patent 6,699,649). It will be noted that Nishijima is the European Equivalent of EP '101.
3. Claims 1-20 are rejected as being anticipated by or obvious over Oya.
4. Claims 1-12, 8-20 are rejected as being anticipated by or obvious over Van Ackere.
5. Claims 1-13, 18-20 are rejected as being anticipated by or obvious over Iwasaki.
6. Claims 1-13, 18-20 are rejected as being anticipated by or obvious over Yoshioka.

In each one of these, the Examiner had taken the position that each one of these six references inherently possess the value of L^* , u^* , v^* in the CIELAB system and, thus, the R^2 value as recited in the claims.

In order to refute this argument and noting that EP '101 and Nishijima are the same, five different materials were prepared and tested in order to determine their R^2 value. The test results are reported in the Declaration of Mr. Yanagisawa which is attached hereto.

In Mr. Yanagisawa's Declaration, he tests each one of the materials and determines their R^2 values. As can be seen by the data presented in Mr. Yanagisawa's Declaration, none of these materials meet the R^2 values as recited in the claims, namely, none of the references have an R^2 value between 0.998 to 1.000.

Thus, it is respectfully submitted that none of the references teach or suggest the present Invention.

Furthermore, it should be noted that none of the references teach or suggest obtaining an R^2 value at all. Thus, it is respectfully submitted that the claims are patentable over the cited references.

Double Patenting Rejection

Claims 1-20 have been rejected under the judicially created obviousness-type patenting rejection based on the claims of U.S. Patent 6,699,649.

It is respectfully submitted that, based on the tests presented herein, the '649 Patent does not claim the same material as the present Invention and it is not an obvious variant thereof. Respectfully, no Terminal Disclaimer is needed.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in

pending condition, appropriate requests are hereby made and authorization is given to debit account #02-2275.

Respectfully submitted,

MUSERLIAN, LUCAS AND MERCANTI, LLP

By: Donald C. Lucas
Donald C. Lucas
(Attorney for Applicants)
475 Park Avenue South
New York, New York 10016
Tel. # (212) 661-8000

DCL/mr

Encl: Executed Declaration of Mr. H. Yanagisawa
Return receipt post-card